

Appl. No. 10/704,509  
Amdt. Dated June 4, 2008  
Reply to Office Action of March 7, 2008

### **REMARKS/ARGUMENTS**

Claims 1-28 are pending in the present application.

This Amendment is in response to the Office Action mailed March 7, 2008. In the Office Action, the Examiner rejected claims 1-28 under 35 U.S.C. §101; claims 1-6, 9-12, 18-20, and 23-24 under 35 U.S.C. §103(a). In addition, the Examiner indicated allowable subject matter for claims 7-8, 13-17, 21-22, and 25-27 if they are rewritten in independent form including all of the limitations of the base claim and any intervening claims. Reconsideration in light of the remarks made herein is respectfully requested.

#### ***Rejection Under 35 U.S.C. § 101***

In the Office Action, the Examiner rejected claims 1-28 under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. The Examiner recites that "claims to processes that do nothing more than solve mathematical problems ... are non statutory" and "thus, a process consisting solely of mathematical operations without some claimed practical application is drawn to non-statutory subject matter" (Office Action, page 2).

Applicant respectfully disagrees and submits that claims 1-17 are apparatus claims rather than claims to a process such that the requirements of 35 USC §101 do not apply as indicated by the Examiner. In other words, as apparatus claims, claims 1-17 cannot be "a process consisting solely of mathematical operations" as alleged by the Examiner. Moreover, claim 18 recites "the formant parameters and the excitation signal parameters are used to produce digital signals representing a voice to be transmitted." Thus, independent claim 18 recites a practical application of the method in the technologic art of transmitting voice in the form of digital signals.

Therefore, independent claims 1 and 18 and claims dependent thereon are directed at statutory matter. Accordingly, Applicant respectfully requests the rejection under 35 USC §101 be withdrawn.

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***Rejection Under 35 U.S.C. § 103***

In the Office Action, the Examiner rejected claims 1 and 18 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,260,009 issued to Dejaco ("Dejaco") in view of U.S. Patent No. 6,711,538 issued to Omari et al. ("Omari '538"); and claims 2-6, 9-12, 19-20, and 23-24 under 35 U.S.C. §103(a) as being unpatentable over Dejaco, in view of Omari '538, and further in view of U.S. Patent No. 6,539,355 issued to Omari et al. ("Omari '355"). Applicant respectfully traverses the rejection and submits that the Examiner has not met the burden of establishing a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP §2143, p. 2100-126 to 2100-130 (8th Ed., Rev. 5, August 2006)*. Applicant respectfully submits that there is no suggestion or motivation to combine their teachings, and thus no *prima facie* case of obviousness has been established.

As indicated in the previous Response to Office Action dated July 11, 2007, while Dejaco discusses converting from input CELP format to output CELP format, there is no mention of a narrowband bitstream or a wideband CELP format. The Examiner alleges that the input narrowband bitstream and the output wideband CELP format is taught by Omari '538, citing to column 1, lines 17-30, which states that "the receiving side performs a band-spreading process on the received narrow-band signal so that the signal is converted into a wide-band signal."

However, the Examiner failed to show there is a teaching, suggestion, or motivation to combine the references. The Examiner merely states "it would have been obvious to one of ordinary skill in the art to combine the method of converting parameters from narrowband to wideband for the benefit of improving sound quality, citing to Omari '538, col. 1, lines 17-30. The Examiner impermissibly uses hindsight based on the invention to defeat patentability of the invention.

Furthermore, the Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), stated: "Under § 103, the scope and content of the prior art are to be determined;

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differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined." MPEP 2141. In *KSR International Co. vs. Teleflex, Inc.*, 127 S.Ct. 1727 (2007) (Kennedy, J.), the Court explained that "[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue." The Court further required that an explicit analysis for this reason must be made. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR 127 S.Ct.* at 1741, quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). In the instant case, Applicant respectfully submits that there are significant differences between the cited references and the claimed invention and there is no apparent reason to combine the known elements in the manner as claimed, and thus no *prima facie* case of obviousness has been established.

The Examiner failed to establish a *prima facie* case of obviousness and failed to show there is teaching, suggestion, or motivation to combine the references. When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to: (A) The claimed invention must be considered as a whole; (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (D) Reasonable expectation of success is the standard with which obviousness is determined. Hodosh v. Block Drug Co., Inc., 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986). "When determining the patentability of a claimed invention which combined two known elements, 'the question is whether there is something in the prior art as a whole suggest the desirability, and thus the obviousness, of making the combination.'" In re Beattie, 974 F.2d 1309, 1312 (Fed. Cir. 1992), 24 USPQ2d 1040; Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 1462, 221 USPQ (BNA) 481, 488 (Fed. Cir. 1984). To defeat patentability based on obviousness, the suggestion to make the new product

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having the claimed characteristics must come from the prior art, not from the hindsight knowledge of the invention. Interconnect Planning Corp. v. Feil, 744 F.2d 1132, 1143, 227 USPQ (BNA) 543, 551 (Fed. Cir. 1985). To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness. In other words, the Examiner must show reasons that a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the prior elements from the cited prior references for combination in the manner claimed. In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1996), 47 USPQ 2d (BNA) 1453. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or implicitly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973. (Bd. Pat. App. & Inter. 1985). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Furthermore, although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." In re Mills 916 F.2d at 682, 16 USPQ2d at 1432; In re Fritch, 972 F.2d 1260 (Fed. Cir. 1992), 23 USPQ2d 1780.

The Examiner has not made an explicit analysis on the apparent reason to combine the known elements in the fashion in the claimed invention. Accordingly, there is no apparent reason to combine the teachings of Dejaco and Omori '538.

Therefore, Applicant believes that independent claims 1 and 18 and their respective dependent claims are distinguishable over the cited prior art references. Accordingly, Applicant respectfully requests the rejection under 35 U.S.C. §103(a) be withdrawn.

#### *Allowable Subject Matter*

Applicant notes with appreciation the Examiner's indication of allowable subject matter. The Examiner objects to claims 7-8, 13-17, 21-22, and 25-27 as being dependent on a rejected base claim, but indicates that the claims would be allowable if rewritten in independent form

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including all of the limitations of the base claim and any intervening claims. However, in light of the arguments set forth above, Applicant respectfully requests that independent claims 1 and 18 and all claims that depend therefrom be allowed.

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**Conclusion**

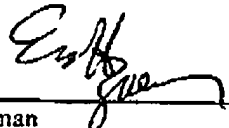
Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: June 4, 2008

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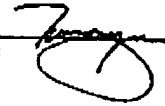
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